



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,752	03/24/2000	Rudolf Hinterwaldner	3214	2843

7590

02/13/2002

Thomas G Scavone
Niro Scavone Haller & Niro
181 West Madison Street
Suite 4600
Chicago, IL 60602

EXAMINER

JOHNSON, JERRY D

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 02/13/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/534,752

Applicant(s)

HINTERWALDNER ET AL.

Examiner

Jerry D. Johnson

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1764

Applicant's election without traverse of claims 1-14 in Paper No. 6 is acknowledged.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6-11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by

Laepple et al.

Laepple et al, U.S. Patent 4,303,537, teach an aqueous lubricant composition comprising (a) about 60-80 wt %, especially 65-75 wt % water; (b) about 15-30 wt %, particularly about 18-25 wt % of a solid lubricant combination of molybdenum disulfide and graphite, (c) about 5-10 wt %, particularly about 6-8 wt %, acrylic resin as binder; (d) about 0.1-2 wt %, particularly about 0.4-0.8 wt %, of a dispersing and/or wetting agent, and (e) on occasion, about 0.1-1 wt %, especially about 0.3-0.7 wt %, of the additional auxiliary substances (column 2, lines 30-53). As dispersing and/or wetting agent (d), an ammonium salt of a low-molecular polyacrylic acid has proved to be especially suitable (column 3, lines 66+). As additional components, organic nitrite is taught in column 4, lines 29-36. In example 1, columns 5 and 6 of Laepple et al., an aqueous composition containing graphite, molybdenum disulfide, low-molecular weight polyacrylic acid and acrylic resin is disclosed.

Claims 1-3, 6, 7 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobs.

Jacobs, U.S. Patent 5,180,509, teaches metal-free lubricant compositions comprising graphite for use in threaded connections (column 1, lines 9-11). The composition of the

Art Unit: 1764

invention also comprises a polymeric material which is chosen from polyalkylene polymers, preferably branched polyalkylenes. Suitable polymers include polyethylene, polypropylene and polybutylene (column 3, lines 34-40). Addition of a friction adjusting component chosen from mica, vermiculite, calcium phosphate, magnesium phosphate, zinc phosphate, calcium oxide, magnesium oxide, zinc oxide, calcium carbonate, magnesium carbonate and zinc carbonate is taught in column 3, line 65 to column 4, line 2.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the terms "chemically reacting and/or inert binder" and "substance which releases gases at elevated temperature" are indefinite. The claims fail to define the conditions under which the substance is "chemically reacting", "inert" or "releases gases". The limitation "releases gases at elevated temperature" is subjective and indefinite. Additionally, it is noted that practically all substances "release gases" under some conditions. While claims are interpreted in light of the disclosure, it is improper to read the limitations of the specification in to the claims.

Claim 2 fails to define the conditions under which the claimed gas yield is obtained.

In claim 3, the terms "hydrazine derivatives", "carboxylic acids and derivatives thereof" and "explosive substances" are indefinite.

Art Unit: 1764

Claim 8 fails to define the condition under which the claimed monomers, polymers or copolymers are "reactive."

Claim 10 fails to define the conditions under which the claimed polymers and copolymers are "inert."

Claim 14 fails to define the conditions under which the claimed additives are "electrically conductive or thermally conductive substances." Additionally, it is noted that the specification, page 17, teaches that graphite is an electrically conductive or thermally conductive substances. However, graphite is also disclosed and specifically claimed as a friction-reducing additive. Accordingly, claim 14 is indefinite. The same is true of claims 1-13, wherein broadly claimed components a), b) and c) are not mutually exclusive and are not defined. For example, claim 6 includes polyolefins as one of the claimed friction-reducing additives. Yet claim 11 includes polyolefins as one of the claimed inert binders. Accordingly, claims 1-14 are indefinite.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (703) 308-2515. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

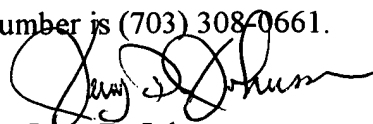
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications.

Application/Control Number: 09/534,752

Page 5

Art Unit: 1764

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jerry D. Johnson
Primary Examiner
Art Unit 1764

JDJ
February 11, 2002